

Serial No.: 10/595,279
Docket No.: 09792909-6676
Amendment "A" dated April 1, 2008
Reply to the Office Action of January 2, 2008

REMARKS

A. Introduction

Claims 1-17 were pending and under consideration in the application.

In the Office Action of January 2, 2008 claim 1 and its dependent claims, claims 2-4, were rejected under 35 U.S.C. §112, second paragraph as being indefinite.

Claims 1, 3, 5, 7, 9-11, 13, and 15 were rejected under 35 U.S.C. §102(e) as being anticipated by Takahashi, U.S. 2007/0001921 (hereinafter, "Takahashi").

Claims 12 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi.

Claims 2, 4, 6, 8, 14 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Mizoguchi, et al., U.S. 6,593,841, (hereinafter, "Mizoguchi").

In response, claim 1 is being amended to obviate the §112 rejection, and the remaining claims are being amended for clarity, to cure informalities, and to clarify that a magnetic core member for an antenna module stack is stacked with a loop-shaped antenna coil and that a surface of the magnetic core member facing the antenna coil has an annular-shaped recess disposed in a region corresponding to the loop-shape of the antenna coil. Support for the amendment is found, at least, in figure 1 and paragraphs 0058-0060. (Paragraph references are with respect to the application as published as U.S. 2007/0069961). Accordingly, no new matter is being added.

B. Rejections under 35 U.S.C. 112, second paragraph

Claim 1 and its dependent claims, claims 2-4, were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. Claim 1 has been amended to obviate the §112 rejection.

C. Rejections under 35 U.S.C. 102(e)

Claims 1, 3, 5, 7, 9-11, 13, and 15 were rejected under 35 U.S.C. §102(e) as being anticipated by Takahashi.

Takahashi discloses an antenna module having a magnetic core member disposed between an antenna substrate and a conductive shield plate, where the magnetic core member has a layered structure providing a result that magnetic properties of a surface of the member opposed to the antenna substrate are different from magnetic properties of a surface of the member opposed to the shield plate. Takahashi, abstract. In some embodiments, Takahashi proposes accomplishing the above-mentioned result by providing slits or grooves in the surface opposing the antenna substrate. Takahashi further discloses slits and grooves in a matrix- or grill-shaped pattern. Takahashi, ¶¶0103-0108.

Takahashi fails to teach or suggest a groove or slit having an annular shape where the annular shape is formed in a region of the surface corresponding to the loop-shape of the antenna coil, as presently claimed in each of independent claims 1, 5, and 13. A finding that a claim is anticipated requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because Takahashi fails to disclose at least the feature of the claims discussed above, claims 1, 5 and 13, and their respective dependent claims, claims 3, 7, 9-11 and 15 are patentable over Talbot.

D. Rejections under 35 U.S.C. 103(a)

1. Claims 12 and 17 were rejected as being unpatentable over Takahashi. Claim 12 depends from claim 5; claim 17 depends from claim 13. Independent claims 5 and 13 are patentable for the reasons given in part C above. Because a dependent claim includes all the limitations of the claim from which it depends, claims 12 and 17 are likewise patentable over Takahashi. The Office Action asserts that it would have been obvious to one having ordinary skill in the art to

Serial No.: 10/595,279
Docket No.: 09792909-6676
Amendment "A" dated April 1, 2008
Reply to the Office Action of January 2, 2008

modify the Fe-Si-Al magnetic powder system of Takahashi by replacing aluminum with chromium. Even if true, claims 12 and 17 are patentable over Takahashi for the reasons given above.

2. Claims 2, 4, 6, 8, 14 and 16 were rejected as being unpatentable over Takahashi in view of Mizoguchi.

As admitted in the Office Action, paragraph 7, Takahashi fails to disclose an annular groove formed in a region corresponding to the loop portion of the antenna coil. Mizoguchi fails to cure this deficiency. Mizoguchi discloses a planar magnetic element (e.g., an inductor) wherein a conducting element arranged in a square or rectangular-shaped spiral path is disposed between a first and second planar magnetic layer. A problem of magnetic saturation of the magnetic layers is mitigated by providing spiral grooves corresponding to the square or rectangular-shaped spiral path of the coil conducting element. Mizoguchi, col. 20, lines 47-62 and Fig. 38.

Mizoguchi fails to disclose an annular groove, as presently claimed. Because this feature is not taught or suggested by the combination of Takahashi and Mizoguchi, the Office Action fails to establish that the invention as a whole is obvious in light thereof. See MPEP 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F. 2d 1382, 1385.

Serial No.: 10/595,279
Docket No.: 09792909-6676
Amendment "A" dated April 1, 2008
Reply to the Office Action of January 2, 2008


E. Conclusion

In view of the foregoing, it is submitted that claims 1-17 are allowable and that the application is in condition for allowance. Early notice to that effect is respectfully requested.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,

SONNENSCHN NATH & ROSENTHAL LLP

By 

Michael L. Day, Reg. No. 55,101
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
415-882-5064 (telephone)
415-882-0300 (facsimile)
ATTORNEYS FOR APPLICANTS